

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re	)	
	)	Decision on
	)	Petition for Regrade
	)	Under 37 C.F.R. § 10.7(c)
_____	)	

**MEMORANDUM AND ORDER**

(Petitioner) petitions for regrading her answers to questions 9, 26, 30, 34, 36, 38 and 44 of the morning section of the Registration Examination held on August 26, 1998. The petition is denied.

**BACKGROUND**

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 62 on the morning section. On December 28, 1998, Petitioner requested regrading of seven two-point questions on the morning section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

**OPINION**

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question 9 reads as follows:

9. Able, a researcher with the Royal Fruit Co. (hereinafter "Royal"), discovered a distinct and new variety of peach tree which he successfully succeeded in asexually reproducing. Royal then obtained an assignment from Able, and filed a plant patent application with the PTO claiming the asexually reproduced peach tree. Subsequently, Baker, a researcher with the Georgia Peach Co. (hereinafter "Georgia"), unaware of Able's discovery, discovered a similar though independent and patentably distinct variety of peach tree. Baker succeeded in asexually reproducing his discovery. Georgia then obtained an assignment from Baker and filed a utility patent application with the PTO claiming the fruit and propagating material of the Baker peach tree. Subsequently, Georgia merged with Royal, which acquired title to all of Georgia's assets, including the Baker utility patent application. In the course of prosecution of the Baker patent application, the primary examiner "provisionally" rejected all of the claims in the Baker application on the ground of obviousness-type double patenting with the claims in Able's application. On the basis of the present factual scenario and proper PTO practice and procedure, which of the following statements is true?

- (A) The rejection is improper because while there is a common relationship of ownership, a common relationship of inventorship is lacking.
- (B) The rejection is improper because the Able and Baker inventions are independent and patentably distinct from each other.
- (C) The rejection is improper because there was no common relationship of ownership at the time of Baker's invention.
- (D) The rejection is proper because the issue of double patenting can be addressed without violating the confidential status of the applications as required by 35 U.S.C. § 122.
- (E) The rejection is improper because a provisional double patenting rejection cannot be based on copending utility and plant patent applications.

The correct answer is (B) and Petitioner selected answer (C). The question asks which of five statements relating to the propriety of a provisional rejection of Baker's claims on the ground of obviousness-type double patenting is true on the basis of the factual scenario presented and proper PTO practice and procedure. Answer (B) is correct because the facts indicate that the inventions are independent and patentably distinct, and

that the double patenting rejection is of the obviousness type. Manual of Patent Examination Procedure (“MPEP”) § 804 reads:

There are . . . two types of double patenting rejections. One is the “same invention” type double patenting rejection . . . . The second is the “nonstatutory-type” double patenting rejection . . . which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes rejections based on . . . obviousness.

Petitioner’s selection, choice (C), is incorrect because, as shown in MPEP § 804, CHARTS I-B and II-B, provisional double patenting rejections may be justified regardless of whether common ownership existed at the time of applicant’s invention. Petitioner contends that choice (C) is correct, arguing that a double patenting rejection is proper only when there is common inventorship or ownership and that the examiner’s subsequent knowledge of the merger of Royal and Georgia Peach Co. should not prompt a provisional double patenting rejection. This argument, however, does not point out any error in the grading of Petitioner’s examination.

First, the argument assumes facts not given, i.e., that the examiner knows that the inventions were not commonly owned at the time of invention and that Royal and Georgia merged. The instructions on the test booklet warn against assuming facts not given to answer the questions. In requesting regrade, arguments premised in any manner on assumptions show no error in grading the examination.

Second, the practice and procedure followed by the PTO when the applications are commonly owned, have different inventive entities, but do not have common ownership at the time of an applicant’s invention is referenced in Charts I-B and II-B of

MPEP § 804. In particular, see the boxes across the bottom of the charts. Among the possible rejections in the charts is obviousness-type double patenting. As the discussion in MPEP § 804, Subsection II, makes clear, such a rejection is not dependent on common ownership existing at the time of Baker's invention. See form paragraphs 8.33, 8.34, and 8.35 in MPEP § 804, Subsection II. Thus, lack of "common relationship of ownership at the time of Baker's invention" referenced in choice (C) is not sufficient in itself to cause an obviousness-type double patenting rejection to be improper. In contrast, where the inventions are independent and patentably distinct from each other, as in choice (B), that alone is sufficient to render the rejection improper. No grading error has been shown.

Question 26 reads as follows:

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block decoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider having two inputs and one output. The functions of the phase comparator and divider are adequately disclosed in the specification. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phrase [sic, phase] comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.

- (B) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, and that these elements were “routinely built.”
- (C) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built,” and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.”
- (E) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The professor was involved with the construction of the digital transmission system.

Both (C) and (D) are accepted as correct answers and Petitioner selected answer (B). The question asks which of five declarations would be minimally legally sufficient to overcome the examiner’s rejection in accordance with proper PTO practice and procedure. The declarations in both answer (C) and answer (D) state that the divider and phase comparator were “well-known to those of skill in the art as of June 17, 1997” and that these elements were “routinely built.” Answer (C) also states that the declarant “provides details in the declaration concerning the structure and function of the elements.” Choice (C) contains additional “details” so as to constitute “something more than a conclusory statement” as referred to in MPEP § 2164.05. Providing these details in the

declaration directly answers the examiner's concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. See fact pattern to question ("the claims [stand rejected] under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed") (emphasis added).

As such, credit has been given for answer (C). As explained in MPEP § 2164.05, "[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement." *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) ("expert's opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement").

The declaration in (D) states that these elements were "sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university." The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. Again, having this statement in the declaration directly answers the examiner's concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. For these reasons, (D) is a correct answer. A specification need not disclose what is well-known to those skilled in the art and may omit that which is well-known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Petitioner contends that choice (B) should also be given credit because it provides information which would be minimally sufficient to overcome the rejection. Petitioner asserts that the declaration in choice (B) would be convincing because one skilled in the art would know that the articles are “well-known” and “routinely built” and correctly points out that MPEP § 2164.05, paragraph 1, states that the “evidence provided by applicant need not be conclusive, but merely convincing to one skilled in the art.” This argument concerning answer (B), however, does not point out any errors in the grading of Petitioner’s examination because while the above MPEP statement addresses the degree of proof, it does not address the type of evidence presented, and the weight accorded the evidence. An expert’s opinion in a declaration is evidence that will be considered. However, the opinion, particularly if it is only a conclusory statement on the ultimate legal conclusion, is not necessarily convincing evidence. As stated in *Buchner*, an “expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement.” 929 F.2d at 661, 18 USPQ2d at 1332. As stated in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.”

Additionally, what answer (B) also lacks is a declaration which includes a direct answer to the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. In sharp contrast, the declarations in answers (C) and (D) do not lack this direct response to the examiner’s concern. In view of the above, no grading error has been shown.



Question 30 reads as follows:

30. Inventor X, a citizen of Germany, invented a tape dispenser in Germany on May 5, 1996. On January 22, 1997, X filed a patent application for the tape dispenser in the German Patent Office. On January 22, 1998, you filed a complete U.S. patent application in the PTO claiming a tape dispenser on behalf of X. The U.S. application was filed with a declaration under 37 CFR § 1.63 signed by X claiming foreign priority of the German patent application. In an Office action dated June 17, 1998, and setting a three month shortened statutory period for reply, a primary patent examiner properly rejected all the claims in the U.S. patent application as being anticipated under 35 U.S.C. § 102(a) by the disclosure in magazine articles describing how to make and use an identical tape dispenser. The articles were published in the United States in February 1997, and in Great Britain in March 1997. Which of the following actions accords with proper PTO practice and procedure, and represents the most appropriate action for overcoming the rejection?

- (A) On or before September 17, 1998, file a certified copy of the German application, and an English translation of the German application.
- (B) On or before September 17, 1998, file a certified copy of the German application, an English translation of the German application, and point out that the reference is no longer available as prior art.
- (C) File a reply on or before September 17, 1998, which argues that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article.
- (D) File an affidavit under 37 CFR § 1.132 signed by you stating that the reference cannot be used because the application which inventor X filed in the German Patent Office antedates the articles.
- (E) File a petition to have the Commissioner exercise his supervisory authority and withdraw the rejection stating that the reference cannot be properly used inasmuch as the declaration under 37 CFR § 1.63 makes clear that the application inventor X filed in the German Patent Office antedates the articles.

The correct answer is (B) and Petitioner chose answer (C). Answer (B) complies with proper PTO practice and procedure. To perfect a claim of foreign priority, the claim for benefit of foreign priority must be filed, along with a certified copy of the foreign application, 35 U.S.C. § 119(b), and an English translation of the foreign application,

37 C.F.R. § 1.55. Additionally, the practitioner must reply to the rejection by pointing out that the reference is no longer available as prior art. 37 C.F.R. § 1.111(b).

Petitioner contends that (C) is the most correct answer because it provides a timely, substantive response referring to the filing date of the German application which antedates the cited articles. Petitioner also contends that (B) is not responsive to the examiner's "objection" because it provides only two documents and merely "points out" that the reference is no longer available as prior art. The argument does not point out any errors in the grading of Petitioner's examination. Petitioner has not pointed out any authority for the proposition that prior art used in a rejection under 35 U.S.C. § 102(a) may be antedated by only "arguing that the reference cannot be used because the application inventor X filed in the German Patent Office antedates the article." As discussed in MPEP § 201.15, a certified copy of the German application and an English translation must be filed to overcome the rejection. "If the petitioner argues the reference, the examiner, in the next action in the case, may specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or he or she may merely continue the rejection." MPEP § 201.15. These documents were not filed in choice (C). Therefore, they must still be filed to overcome the rejection.

The response in (B) of "point[ing] out that the reference is no longer available as prior art" is sufficiently substantive to be responsive to the rejection. Contrary to Petitioner's suggestion that the response must support the claim that the reference is no longer available as prior art by distinctly showing that the filing date of the German patent antedates the article, there is no requirement as to the form of the response. As stated in

MPEP § 201.15, “[t]he applicant in his or her response may . . . present the foreign papers for the purpose of overcoming the date of the reference.”

Petitioner also contends that (B) is deficient because it lacks “certification that the translation is accurate.” There is no requirement for “certification.” MPEP § 201.15 does point out that a “translation must be filed together with a statement that the translation of the certified copy is accurate.” Such a statement is not referenced in choice (B).

Nevertheless, among the provided answers, choice (B) is the most correct answer because it most nearly complies with PTO practice and procedure by providing a certified copy of the German application, an English translation of the German application, and pointing out that the reference is no longer available as prior art. No grading error has been shown.

Question 34 reads as follows:

34. On November 6, 1997, the practitioner filed a complete patent application, filing fee, and declaration under 37 CFR § 1.63 identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. Inventors A and B did not assign, and were under no obligation to assign their rights in the invention to any other party. A primary examiner required restriction between the invention of Claims 1-5, and the invention of Claims 6-10. The practitioner elected the invention of Claims 1-5. The examiner withdrew Claims 6-10 from consideration. On July 15, 1998, the practitioner filed a reply to a first Office action dated May 8, 1998, which did not set a period for reply. In the reply, Claims 6-10 were canceled, and Claims 1 and 3 were amended by adding limitations supported by information disclosed, but unclaimed in the application. The limitations were substantially embraced by the statement of invention in the application. Claim 1 is an independent claim, and Claims 2-5 depend directly or indirectly from Claim 1. On August 1, 1998, inventors A and B then provided the practitioner with information clearly showing that Claims 1-5, as amended, were not the joint invention of A and B, and that such error arose without deceptive intent. Which of the following actions fulfills proper PTO practice and procedure for correcting inventorship?

- (A) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file an amendment to name only A as the sole inventor of the invention set forth in Claims 1-5, together with a statement by the practitioner to correct the inventorship. The foregoing should be filed promptly, and preferably before the next Office action.
- (B) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file an amendment deleting B as an inventor, and adding C as a joint inventor. The amendment should be accompanied by a petition including a statement by B and C that the error in inventorship occurred without deceptive intent on their part, a statement identifying B as the named inventor who is being deleted and acknowledging that B's invention is no longer being claimed, and a statement by C that the amendment is necessitated by the amendment of the claims. An oath or declaration under 37 CFR § 1.63 by A and C should also accompany the amendment. The foregoing should be filed promptly, and preferably before the next Office action.
- (C) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventor only A, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (D) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventors A and C, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application, and addition of C as an inventor. The request is accompanied by a new declaration under 37 CFR § 1.63 naming A and C as the inventors. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (E) All of the above.

The correct answer is (C) and Petitioner selected answer (B). The question inquires which of four actions fulfills proper PTO practice and procedure for correcting inventorship. Choice (C) is the most correct answer because the procedure in (C) follows the practice set forth in 37 C.F.R. § 1.53(d), including subsection (d)(4). A newly executed oath or declaration is not needed inasmuch as none is required when a continuation application is filed under the continuing prosecution application procedure in § 1.53(d).

The procedure in (B) is incomplete because the petition fee has not been paid. Petitioner acknowledges that choice (B) is deficient in omitting to specify that a fee is included in the requirements for fulfilling correction of inventorship under 37 C.F.R. § 1.48(a). Petitioner urges that (B) is otherwise substantively correct. The argument does not point out any errors in the grading of Petitioner's examination. Inasmuch as Petitioner admits that a petition fee is required and not provided for in (B), there is no dispute that (B) is an erroneous answer. Any suggestion that it is correct because it is otherwise substantively correct does not show any error in grading the answer Petitioner selected.

Petitioner urges that choice (C) is incomplete because it fails to require that a new oath or declaration be submitted. This argument is unpersuasive. Choice (C) follows the changes in PTO practice and procedure resulting from the amended rules published in the *Federal Register* on October 10, 1997, 62 FR 53131. The revisions became effective on December 1, 1997. Thus, the revisions were in effect well before Petitioner took the registration examination administered on August 26, 1998, and were, therefore, controlling as of the examination, i.e., 37 CFR § 1.53 was amended. Among the

amendments to section 1.53 is the revision of subsection (d)(1) describing the application filing requirements for continued prosecution applications (CPA). Section 1.53 was also amended by adding Subsection (d)(4), which provides for filing a CPA:

“by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application.”

There is nothing in 37 C.F.R. § 1.53(d)(1) and (d)(4) requiring an oath or declaration be filed where the CPA application is “filed by fewer than all the inventors named in the prior application.” To delete an inventor, a statement requesting deletion is necessary. 37 C.F.R. § 1.53(d)(4). The CPA will utilize the file jacket (including the same application number and filing date) and contents of the prior application to constitute the new application. A new oath or declaration under 37 C.F.R. § 1.63 is not required. 37 C.F.R. § 1.53(d). When correcting inventorship in a nonprovisional patent application other than a reissue application, a new oath is only required when the application discloses unclaimed subject matter not by an inventor or inventors not named in the application. 37 C.F.R. § 1.48(c). No grading error has been shown.

Question 36 reads as follows:

36. Which of the following statements regarding a CPA application is correct?

- (A) A proper CPA division application is filed on August 17, 1998, where, on February 20, 1998, a final Office action setting a three month shortened statutory period for reply was mailed in a prior application; and on August 17, 1998, a request is filed by facsimile for a CPA division application of the prior application; the request, signed by the practitioner, includes an authorization to charge small entity fees under 37 CFR § 1.16 to a deposit account, identifies the correct application number of the prior application; and refers to and is accompanied by a preliminary amendment causing the CPA application to have two independent claims, and 12 dependent claims.
- (B) A CPA continuation application stands abandoned where, before the abandonment of a prior application wherein there was a final rejection, a request was filed in the PTO on December 8, 1997, for a CPA continuation application of the prior application; the request was filed without a filing fee; the PTO sent to the practitioner a Notice To File Missing Parts of Application dated December 17, 1997, requiring payment of the \$790.00 filing fee, and \$130.00 surcharge on or before February 17, 1998; and on July 17, 1998, the practitioner files a petition and check covering the fees for a five month extension of time, the filing fee, and surcharge.
- (C) An improper, as opposed to a proper CPA division application, has been filed where a Notice of Allowance and Issue Fee Due setting a three month statutory period for reply was mailed in a prior application on February 4, 1998; the issue fee was never paid; a completed request for a CPA division application was filed in the PTO on May 6, 1998, with a certificate of mailing by first class mail under 37 CFR § 1.8; the certificate is dated May 4, 1998; and the request correctly identifies the application number of the prior application and is signed by the practitioner.
- (D) A proper CPA continuation application has been filed where a provisional application was filed in the PTO on August 12, 1997; a completed request for a CPA continuation application was filed by hand delivery in the PTO on August 11, 1998; and the request correctly identifies the application number of the prior provisional application and is signed by the practitioner.

- (E) A design application may be properly filed as CPA divisional application of a prior utility application by filing, during the pendency of the prior utility application, a completed request, signed by the practitioner, which correctly identifies the application number of the prior application, together with a preliminary amendment canceling the original specification and substituting a design specification.

The correct answer is (C) and Petitioner selected answer (A). The question inquires which of five statements regarding a CPA application is correct. Choice (C) is the most correct answer because, as provided in 37 C.F.R. §§ 1.8 and 1.53, there is no continuity between the prior application and the CPA application. A certificate of mailing may not be used for filing a request for a continued prosecution application. 37 C.F.R. § 1.8(a)(2)(i)(A). The prior application became abandoned on May 5, 1998, for failure to pay the issue fee. 37 C.F.R. § 1.135(a); MPEP § 1306; 37 C.F.R. § 1.316; 35 U.S.C. § 151. The request was filed on May 6, 1998, after the prior application became abandoned. Thus, the request does not satisfy the requirement of 37 C.F.R. § 1.53(d) that the request be filed before the abandonment of the prior application. If continuity with the prior application cannot be established upon petition to revive, the application may be accorded a filing date upon petition under 37 C.F.R. § 1.53(e) to convert the application to a 37 C.F.R. § 1.53(b) application.

Petitioner contends that choice (C) is not the most correct answer because the filing date may be corrected under 37 C.F.R. § 1.53(e). However, this argument does not show any grading error. The question inquired which of five statements is correct. It did not inquire about correcting a filing date. The statement in (C) pertains to whether the CPA application is improperly filed, not to whether the filing date may be corrected.



Petitioner contends that (A) is the most correct answer because the procedures followed in submitting the CPA are in conformance with the requirements of 37 C.F.R. § 1.53 (d). In (A), the CPA division application is improper, and should not be assigned a filing date. A CPA application must be filed before the abandonment of the prior application. 37 C.F.R. § 1.53 (d)(1)(ii)(B). The request for the CPA was filed in the sixth month after the Office action setting a three month shortened statutory period for reply. The authorization to charge small entity fees under 37 C.F.R. § 1.16 does not authorize payment of extension of time fees, which are set in 37 C.F.R. § 1.17. The prior application became abandoned on May 21, 1998, for lack of a timely reply with an extension of time.

Petitioner argues that the facts do not indicate that an extension of time would or would not be sent by August 20, 1998, and if not, a CPA would have existed for the brief period of time prior to abandonment of the parent application. The argument does not point out any errors in the grading of Petitioner's examination. First, the argument assumes facts not given, i.e., that an extension of time and payment may be filed by August 20, 1998. The instructions on the test booklet warn against assuming facts not given to answer the questions. In requesting regrade, arguments premised in any manner on assumptions show no error in grading the examination. Second, the argument does not show that the procedures followed in submitting the CPA are in accord with the practices and procedures followed by the PTO. A request for the CPA application must be filed before the abandonment of the prior application. 37 C.F.R. § 1.53(d)(1)(ii)(B). In the given situation, no extension of time and fee for the same was filed. The prior application becomes abandoned on May 21, 1998. Thus, the prior application does not continue to

be pending on August 17, 1998, when the request is filed. Consequently, a CPA was not properly filed on August 17, 1998. No grading error has been shown.

Question 38 reads as follows:

38. Inventor A, with the assistance of a registered patent practitioner P, filed a patent application. The PTO mailed to P an Office action. P, a sole practitioner, received the Office action. The application became abandoned for failure to respond within the three month shortened statutory period for reply specified in the Office action. A asked P every three months about the status of the application. P always advised A that the application was pending. P did not revive the application. Using letters, and billing A for work not performed in the application, P mislead [sic, misled] A into believing that the application was pending. Inventor A first learned of the abandoned status of the application in a telephone conversation with the primary examiner on June 12, 1998. On June 14, 1998, A engaged another practitioner, X, to assist in reviving and prosecuting the application. Since June 12, 1998, P has refused to respond to letters he received from A and X by certified mail, or to telephone calls from A and X, wherein A and X have requested P to provide a factual statement explaining what occurred. Inventor A, with the assistance of practitioner X, filed a petition to revive the application on August 25, 1998. Which of the following complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action?

- (A) Where the application was filed on May 9, 1995, and became abandoned on March 5, 1997, for no reply to an Office action dated December 4, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and a showing, corroborated by supporting documents and affidavits from A and X, demonstrating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.

- (B) Where the application was filed on June 10, 1996, and became abandoned on March 21, 1997, for no reply to an Office action dated December 20, 1996, file a petition, accompanied by the petition fee, a terminal disclaimer for 17 months which is proper in all formal respects, the disclaimer fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the Office action, A had sought status information from P every three months since November 1996, P misled A regarding the status of the application, and P has failed to respond to communications requesting P's assistance in reviving the application, and the entire delay was unavoidable.
- (C) Where the application was filed on April 10, 1997, and became abandoned on May 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition, accompanied by the petition fee, the required reply, and an affidavit signed by X stating that P failed to inform A of the action, P misled A regarding the status of the application, and P has failed to respond to communications from A and X requesting P's assistance in reviving the application.
- (D) Where the application was filed on April 10, 1997, and became abandoned on February 6, 1998, for no reply to an Office action dated November 5, 1997, file a petition to revive accompanied by a terminal disclaimer for 3 months which is proper in all formal respects, an authorization to charge any required fees to a designated account, the required reply, and an affidavit signed by A stating that P failed to inform A of the action, and that A was damaged by P's conduct at least to the extent that A had incurred additional fees and expenses for the petition, and the entire delay was unavoidable.
- (E) None of the above.

Answer (A) is the most correct choice and Petitioner selected answer (C).

The question asks which of five answers complies with PTO practice and procedure for a petition to revive an application for unavoidable delay in replying to an Office action.

Answer (A) is most correct because, in accordance with 37 C.F.R. § 1.137(a) and MPEP § 711.03(c), the petition to revive includes the petition, the appropriate petition fee, a terminal disclaimer, the disclaimer fee, a reply to the last Office action, and a showing that the entire delay in the filing of the reply from the due date to the filing of a grantable petition was unavoidable. In view of evidence that the practitioner, P, concealed the

abandonment from the inventor, A, billed A for work not performed, and gave misleading statements to A with regard to the application, P's lack of diligence cannot be charged to A. *See In re Lonardo*, 17 USPQ2d 1455, 1458 (Comm'r Pats. 1990).

Answer (C) is not the most correct answer because it, unlike answer (A), lacks the fact that A had regularly sought status information from P. "Diligence on the part of the applicant is essential to show unavoidable delay." *Douglas v. Manbeck*, 21 USPQ2d 1697, 1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869 (Fed. Cir. 1992). Accordingly, since there is no showing in answer (C) that A was diligent, answer (A), which includes a showing that "A had sought status information from P every three months since November 1996," is a more correct answer choice.

Answer (C) also lacks an affidavit by A which would inform the PTO what steps, if any, A took to act as a "reasonably prudent person." Such a showing is required to demonstrate unavoidable delay. *See, e.g., In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). In sharp contrast, answer (A) includes such an affidavit with the required showing of diligence by the inventor. Accordingly, overall, answer (A) is more correct than answer (C).

Petitioner argues that answer (C) provides the required showing of diligence inasmuch as P misled A regarding the status of the application, A attempted to discern the status of the application, and an affidavit by X attesting to P's malfeasance is appropriate in this situation because X is professionally cognizant of P's breach of professional responsibility. Contrary to Petitioner's position, answer (C) fails to include the fact that A regularly sought status information from P and an affidavit by A showing diligence on A's part. Additionally, it is the applicant's responsibility, as opposed to a subsequently

hired practitioner for the applicant, to exercise diligence with respect to his or her application and show such diligence to the PTO, which was not done in answer (C).

*Douglas*, 21 USPQ2d at 1700. In view of the above, no error in grading has been shown.

Question 44 reads as follows:

44. Your client, the Happy Co., has come to you and requested that you file an international application under the Patent Cooperation Treaty (PCT) which designates Canada, Mexico, and the European Patent Office. Since today, August 26, 1998, is the last day of the Paris Convention priority year, you are rushing to prepare an application which will be granted an international filing date. Given the following elements, which combination is necessary to have an international filing date granted?

- I. The designation of at least one PCT contracting state.
- II. The payment of the international fee.
- III. A part of the application which appears to be a claim.
- IV. The name(s) of the inventor(s).
- V. An application in a language prescribed by the receiving office.

- (A) I, II, and III.
- (B) I, III, and V.
- (C) I and III.
- (D) II and V.
- (E) I, III, IV, and V.

The correct answer is (B) and Petitioner chose answer (E). Answer (B) is the most correct answer. MPEP § 1810; PCT Article 11. As presented, element I is identified in section (1)(iii)(b) of PCT Article 11, element III is found in section (1)(iii)(e) of PCT Article 11, and element V is set forth in section (1)(ii) of PCT Article 11.

Petitioner contends that (E) is the most correct answer because it expressly follows the listing of required elements under PCT Article 11 inasmuch as section (1)(iii) stipulates that the international application must contain, *inter alia*, “the name of the applicant as prescribed.” The argument does not point out any errors in the grading of

Petitioner's examination. In an international application, "applicant" and "inventor" are not synonymous. As discussed in MPEP § 1817.01:

"[T]he right to file an international application and to designate contracting states or regions (EP or OAPI) exists if the applicant is a resident or national of a contracting state. The applicant can be an individual, corporate entity or other concern. If the United States is to be designated, it is particularly important to note that the applicant must also be the inventor."

Inasmuch as the designated states and region in the given facts do not include the United States, it is not necessary that the inventor be the applicant. Accordingly, the names of the inventors need not be included in the application. No grading error has been shown.

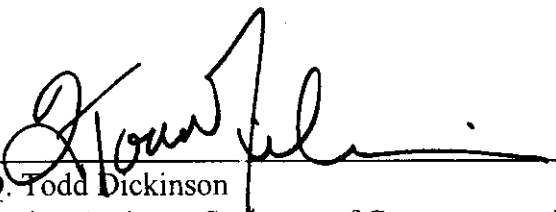
### **ORDER**

For the reasons given above, no points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score remains at 62. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied.

This is a final agency action.

AUG 18 1999

  
Q. Todd Dickinson  
Acting Assistant Secretary of Commerce and  
Acting Commissioner of Patents and Trademarks